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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,264	02/06/2004	Fumihiko Yamaguchi	248606US0	4447
22850	7590	04/03/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			BEFUMO, JENNA LEIGH	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/772,264

**Applicant(s)**

YAMAGUCHI ET AL.

**Examiner**

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Upon review of the restriction it was noted that claims 9 and 10 were mistakenly placed in Group II. Claims 9 and 10 should have been grouped with Group I, because they are drawn to the product claimed in claims 1 – 7.
2. Applicant's election with traverse of Group I, claims 1 – 7, 9, and 10, in the reply filed on January 6, 2006 is acknowledged. The traversal is on the grounds that the process set forth by the examiner would not necessarily produce an artificial leather product with improved properties. This is not found persuasive because the applicant is not claiming improved properties of the artificial leather product. The only properties recited in the claims are the elongation at break and average tenacity of the microfine fibers, and not properties of the entangled nonwoven structure. Further, a product made by the method set forth in the prior Office Action, would meet all the physical limitations claimed in the product claims. Thus, the claimed product can be made by different methods.

The requirement is still deemed proper and is therefore made FINAL.

3. Claim 8 is withdrawn from consideration as being elected to a non-elected invention.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: because the first word of the claim is not capitalized. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 – 7, 9, and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ikeda et al. (Re 31,601).

Ikeda et al. discloses an artificial leather fabric comprising a woven or knitted base fabric layer and at least one nonwoven fabric layer having extremely fine fibers with an average diameter of 0.1 to 6.0 microns bonded to the base fabric layer by hydroentangling (abstract). Specifically the invention comprises a woven or knitted fabric between an upper nonwoven fabric and a lower nonwoven fabric, each nonwoven fabric comprising extremely fine microdenier fibers, randomly entangled with each other (column 5, lines 32 – 40). The fiber diameter of 0.1 to 6 microns corresponds to a fiber denier of 0.0001 to 0.35 (column 5, lines 63 – 66). The composite fabric is impregnated with an elastic polymer and buffed to form a pile layer which consists of numerous extremely fine fibers from one of the outer nonwoven layers (column 5, lines 53 – 62). The examples teach using nonwoven layers which have the same

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sized fibers (Example 1). Thus, the napped side of the fabric is layer I of the fabric and layer II is made from fibers with an equal average fineness as layer I. Further, the outer nonwoven layers will comprise the about the same amount of fibers, such that the ratio of fibers in the first layer to the second layer is about 50/50. Finally, the extremely fine fibers can be made from different polymers including rayon, polyester, polyamide, polyolefins, and copolymers thereof (column 6, lines 13 – 52).

Although Ikeda et al. does not explicitly teach the limitations of average elongation at break and average tenacity for the microfine fibers, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. microdenier fibers of polyamides and polyesters) and in the similar production steps (i.e. hydroentangling the microdenier fiber layers) used to produce the artificial leather fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the process disclosed by Ikeda et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Thus, claims 1 – 7 are rejected.

Claims 9 and 10 are also rejected with claims 1 and 5 since the claims only recite an intended use of the fabric and fails to add any further structural limitations to the composite fabric. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

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8. Claims 1 – 7, 9, and 10 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoneda et al. (2003/0022575 A1).

Yoneda et al. discloses a nonwoven fabric comprising a first layer (side A) made with ultrafine fibers having a fineness of 0.01 to 0.5 decitex and the opposite side (side B) made with ultrafine fibers having a fineness of not more than  $\frac{1}{2}$  of the fineness of the ultrafine fibers in side A (abstract). The composite fabric is coated with an elastic polymer (abstract). The ratio between the fibers in side a to side b is within the range of 80/20 to 20/80 (paragraph 17). The ultrafine fibers can be made from various polymers including nylons, polyesters, and copolymers thereof (paragraph 13). The different layers are subjected to entanglement to produce the laminated web (paragraph 20). A grain layer is formed on the side A of the substrate (paragraph 29). Prior to the grain layer formation the substrate may be subjected to pretreatment such as buffing the fabric's surface for napping to improve the feel and touch of the fabric (paragraph 39). Thus, side A can be treated to create a napped surface, with side B having smaller ultrafine fibers. Also, the fabric can be used to make various products including gloves (paragraph 6).

Although Yoneda et al. does not explicitly teach the limitations average elongation at break and average tenacity for the microfine fibers, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. microdenier fibers of polyamides and polyesters) and in the similar production steps (i.e. hydroentangling the microdenier fiber layers) used to produce the artificial leather fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the process disclosed by Yoneda et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977)

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as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jenna-Leigh Befumo  
March 29, 2006